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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,733	08/13/2003	David P. Horton	49190-8	1732
23971	7590	08/04/2005	EXAMINER	
BENNETT JONES C/O MS ROSEANN CALDWELL 4500 BANKERS HALL EAST 855 - 2ND STREET, SW CALGARY, AB T2P 4K7 CANADA			TUCKER, PHILIP C	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 08/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/604,733	Applicant(s) HORTON, DAVID P.	
	Examiner Philip C. Tucker	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims Interpretation

The intended use of the fluid as a drilling fluid, or the additive as an anti-accretion compound is not a distinguishing factor (In re Pearson 181 USPQ 641). Claims 2-9, do not positively cite that the specified compounds are present, and thus are rejectable over prior art which does not specifically teach these compounds.

Claim Objections

1. Claims 12-17 are objected to because of the following informalities: Claims 12-17 should start with a capitalized letter. In claims 14-17, the term "based-based" is used in describing the drilling fluid. It appears that such should be "aqueous-based".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 teaches DTMPA, which is not defined in the specification or in the claim. It appears that DTPMPA, which was defined in the specification was meant to be claimed.

Double Patenting

4. Claims 1-17 of this application conflict with claims 1-17 of Application No. 10/604754. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-17 of copending Application No. 10/604754. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 9 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Donham (3880764).

Donham teaches an aqueous drilling fluid which comprises BHMTMPMPA in an amount within the scope of the present invention (see claims 1 and 3). The phosphonate may be used in neutralized form (see column 6, lines 32-39).

9. Claims 1-6, 10 and 12-14 are rejected under 35 U.S.C. 102(e and a) as being anticipated by Brady (6569814).

Brady teaches an aqueous well treating fluid which comprises HEDP or ATMP (see claims 1 and 2).

10. Claims 1-4, 9, 10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Fretier (2003/0150613).

Fretier teaches a well treatment fluid which comprises BHMTMPMPA within the scope of the present invention (see Table I and paragraph 0025).

11. Claims 1 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/42539.

WO '539 teaches a method of drilling a subterranean formation, using an anti-accretion additive which is a phosphonate, within the present concentration ranges (see pages 2-3).

12. Claims 1-5, 10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by House (4566976).

Houde teaches a brine which can be used as a drilling fluid (column 1, lines 19-28), which comprises ATMP, same as nitrilotri (methylenephosphonic acid), within the concentration of the present invention (see the example and table I).

13. Claims 1-7 and 10-14 rejected under 35 U.S.C. 102(b) as being anticipated by Brothers (5340397).

Brothers teaches a well treating fluid which comprises water and a phosphonate such as EDTMPA, ATMP, HEDP or DTPMPA in a concentration within the scope of the present invention (see column 10, lines 34-68).

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14. Claims 1-5, 7, 8 and 10-14 rejected under 35 U.S.C. 102(b) as being anticipated by Schapira (6080700).

Schapira teaches a fluid which comprises water and a phosphonate such as EDTMPA, ATMP or DTPMPA in a concentration within the scope of the present invention (see claim 5 and column 7, lines 53-67). Neutralized salts may also be used (column 8, lines 44-61).

15. Claims 1-4 and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Marin (2004/0238451).

Marin teaches an aqueous composition which comprises a magnesium neutralized BHMTMPMPA at a level of 1%, and within the pH of claim 11 (see paragraphs 0006 and 0007).

16. Claims 1 and 3-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hwa (4066398).

Hwa teaches water based fluids which comprise the phosphate ester of diethanolamine or triethanolamine, within the present concentration range (see column 2, lines 4-31). The phosphate ester may be neutralized (see column 3, lines 24-33).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwa (4066398).

Hwa teaches water based fluids which comprise the phosphate ester of ethanolamines, within the present concentration range (see column 2, lines 4-31), which are used as corrosion inhibitors. The phosphate ester may be neutralized (see column 3, lines 24-33). Hwa differs from the present invention in that the specific use of monoethanolamine is not disclosed. Hwa teaches that in general alkanolamines may be used to form the phosphate esters, even those with a single hydroxyl group (see column 3, lines 3-5, and column 2, line 32). It would be obvious to one of ordinary skill in the art to utilize monoethanolamine to form the phosphate esters of Hwa, in view of the teaching of Hwa that alkanolamines may be used to form the phosphate esters, even those with a single hydroxyl group, and further in view of the utility of the homologues diethanolamine and triethanolamine to form the phosphate esters.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3809